

### **REMARKS**

Prior to entry of this paper, Claims 1-29 were pending. Claims 1-29 were rejected. In this paper, Claims 1, 9, 16, 18, 21, and 28 are amended; no claims are cancelled or added. Claims 1-29 are currently pending. No new matter is added by way of this amendment. For at least the following reasons, Applicants respectfully submit that each of the presently pending claims is in condition for allowance.

#### **Claim Rejections – 35 USC § 102**

##### **Rejections Under 102 Over Que**

Claims 1-6 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Que (“Special Edition Using Microsoft Outlook 2000”, Publisher Que, May 17, 2001). Applicants respectfully traverse these rejections, because Que does not disclose, suggest, or make predictable all of the claim limitations. For example, Que does not disclose, suggest, or make predictable the claim limitation of a different application associated with each of the at least one archive. Que discloses only that “Outlook items can be in various places, usually in one of two places.” Emphasis added, Que, page 17-12. None of the places are associated with different applications other than the Outlook application.

Nevertheless, without conceding to a limit in the scope of the overall invention, and reserving the right to file a continuing application, independent Claims 1 and 16 are amended to specify adding the e-mail address to the electronic address book in a priority order based on the criterion. Support is found throughout the specification, including figure 9, page 10, lines 8-17, and page 24, line 29 through page 25, line 17.

Independent Claim 1 is further amended to specify that the e-mail address is added to a folder of the electronic address book that is associated with the application that is associated with the at least one archive that is associated with the e-mail address. Support is found throughout the specification, including figures 1, 2, and 9, page 10, lines 8-17, page 13, line 29 through page 14, line 17, and page 24, line 29 through page 25, line 17.

The cited references do not disclose, suggest, or make predictable the amended limitations. Accordingly, Applicants respectfully request that the rejection of independent Claims 1 and 16

under 35 U.S.C. §102(b) be withdrawn. It is well established that a dependent claim includes the limitations of the independent claim from which the dependent claim depends. Consequently, a dependent claim is patentable for at least the same reasons as the independent claim from which the dependent claim depends. Accordingly, Applicants respectfully request that the rejection of dependent Claims 2-6 and 17-20 under 35 U.S.C. §102(b) also be withdrawn.

#### Rejections Under 102 Over Tafoya

Claims 21-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Tafoya et al. (US Patent 6,952,805, hereinafter "Tafoya"). Applicants continue to traverse these rejections as argued in Applicants' prior response, which are incorporated herein by reference.

Nevertheless, without conceding to a limit in the scope of the overall invention, and reserving the right to file a continuing application, independent Claim 21 is amended to specify parsing the email to determine a relevance rating for the email address based on whether language in the e-mail that is utilized in outgoing e-mails in a selected user's archive of outgoing e-mails. Support is found throughout the specification, including page 25, lines 8-16, page 7, lines 18-22, and page 12, lines 29-31.

Independent Claim 21 is also amended to specify that the e-mail address is added in a priority order based on the relevance rating, wherein the e-mail address is added to a folder of the electronic address book that is associated with the application that is associated with the email. Support is found throughout the specification, including figures 1, 2, and 9, page 10, lines 8-17, page 13, line 29 through page 14, line 17, and page 24, line 29 through page 25, line 17.

The cited references do not disclose, suggest, or make predictable the amended limitations. Accordingly, Applicants respectfully request that the rejection of independent Claim 21 under 35 U.S.C. §102(e) be withdrawn. It is well established that a dependent claim includes the limitations of the independent claim from which the dependent claim depends. Consequently, a dependent claim is patentable for at least the same reasons as the independent claim from which the dependent claim depends. Accordingly, Applicants respectfully request that the rejection of dependent Claims 22-27 under 35 U.S.C. §102(e) also be withdrawn.

Rejections Under 102 Over Creswell

Claims 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Creswell et al. (US Patent 6,564,264, hereinafter "Creswell"). Applicants continue to traverse these rejections as argued in Applicants' prior response, which are incorporated herein by reference.

Nevertheless, without conceding to a limit in the scope of the overall invention, and reserving the right to file a continuing application, independent Claim 28 is amended to specify that the list of e-mail addresses is generated with a first application that is different from a destination application used to generate the destination electronic address book. Support is found throughout the specification, including figures 1 and 2, page 12, lines 4-9, page 13, and line 29 through page 14, line 17.

Independent Claim 28 is further amended to specify that the first defined criterion includes a frequency with which the e-mail is detected in an archive of e-mails that are associated with the destination electronic address book. Support is found throughout the specification, including figure 9, page 9, lines 16-24, page 10, lines 8-17, and page 13, lines 1-4.

Independent Claim 28 is also amended to specify that the first e-mail address is also associated with a first phone number, which is also added to the destination electronic address book. Support is found throughout the specification, including page 16, line 31 through page 17, line 10 and page 26, lines 29-32.

Independent Claim 28 is further amended to specify that the e-mail address and phone number are added in a priority order based on the first defined criterion into a folder of the destination electronic address book that is associated with the first defined criterion. Support is found throughout the specification, including figures 1 and 2 and page 10, lines 8-17.

The cited references do not disclose, suggest, or make predictable the amended limitations. Accordingly, Applicants respectfully request that the rejection of independent Claim 28 under 35 U.S.C. §102(e) be withdrawn. It is well established that a dependent claim includes the limitations of the independent claim from which the dependent claim depends. Consequently, a dependent claim is patentable for at least the same reasons as the independent claim from which the dependent claim depends. Accordingly, Applicants respectfully request that the rejection of dependent Claim 29 under 35 U.S.C. §102(e) also be withdrawn.

### **Claim Rejections – 35 USC § 103**

#### **Rejections Under 103 Over Harms & Huang**

Claims 9-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harms et al. (US Publish 2003/0078981, hereinafter “Harms”) in view of Huang et al. (US Patent 5,966,714, hereinafter “Huang”). Applicants continue to traverse these rejections as argued in Applicants’ prior response, which are incorporated herein by reference.

Nevertheless, without conceding to a limit in the scope of the overall invention, and reserving the right to file a continuing application, independent Claim 9 is amended to specify adding the first retrieved e-mail address to an electronic address book in a priority order based on the first criterion. Support is found throughout the specification, including figure 9, page 10, lines 8-17, and page 24, line 29 through page 25, line 17.

The cited references do not disclose, suggest, or make predictable the amended limitations. Accordingly, Applicants respectfully request that the rejection of independent Claim 9 under 35 U.S.C. §103(a) be withdrawn. It is well established that a dependent claim includes the limitations of the independent claim from which the dependent claim depends. Consequently, a dependent claim is patentable for at least the same reasons as the independent claim from which the dependent claim depends. Accordingly, Applicants respectfully request that the rejection of dependent Claims 10-13 and 15 under 35 U.S.C. § 103(a) also be withdrawn.

#### **Rejections Under 103 Over Que & Creswell**

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Que as applied to claim 1 above, and further in view of Creswell et al. (US Patent 6,564,264, hereinafter “Creswell”). Applicants respectfully traverse this rejection as argued with respect to corresponding independent Claim 1, and as argued in prior responses with regard to Creswell. In any case, the cited references do not disclose, suggest, or make predictable the amended limitations of corresponding independent Claim 1. Consequently, dependent Claim 7 is patentable for at least the same reasons as

independent Claim 1. Accordingly, Applicants respectfully request that the rejection of dependent Claim 7 under 35 U.S.C. §103(a) be withdrawn.

Rejections Under 103 Over Que & Harms

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Que as applied to claim 6 above, and further in view of Harms et al. (US Publish 2003/0078981, hereinafter “Harms”). Applicants respectfully traverse this rejection as argued with respect to corresponding independent Claim 1, and as argued in prior responses with regard to Harms. In any case, the cited references do not disclose, suggest, or make predictable the amended limitations of corresponding independent Claim 1. Consequently, dependent Claim 8 is patentable for at least the same reasons as independent Claim 1. Accordingly, Applicants respectfully request that the rejection of dependent Claim 8 under 35 U.S.C. § 103(a) be withdrawn.

Rejections Under 103 Over Harms, Huang, & Montville

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harms and Huang as applied to claim 12 above, and further in view of Montville et al. (US Patent 6,356,937, hereinafter “Montville”). Applicants respectfully traverse this rejection as argued with respect to corresponding independent Claim 9, and as argued in prior responses with regard to Harms, Huang, & Montville. In any case, the cited references do not disclose, suggest, or make predictable the amended limitations of corresponding independent Claim 9. Consequently, dependent Claim 14 is patentable for at least the same reasons as independent Claim 9. Accordingly, Applicants respectfully request that the rejection of dependent Claim 14 under 35 U.S.C. §103(a) be withdrawn.

### CONCLUSION

It is respectfully submitted that each of the presently pending claims (Claims 1-29) is in condition for allowance and notification to that effect is requested. Examiner is invited to contact the Applicants' representative at the below-listed telephone number if it is believed that the prosecution of this application may be assisted thereby. Although only certain arguments regarding patentability are set forth herein, there may be other arguments and reasons why the claimed invention is patentable. Applicants reserve the right to raise these arguments in the future.

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Respectfully submitted,

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